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EXAMINER

BUTLER, MICHAEL E

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 22

Application Number: 09/014,076
Filing Date: January 27, 1998
Appellant(s): FEDOR ET AL.

MAILED

SEP 15 2004

GROUP 3600

Ralph E. Jocke
For Appellant

RESPONSE TO REMAND FROM THE BOARD FOR EXAMINER QUERIES

This is in response to the Board remand of 7/23/2004.

Response to Remand from the Board for Examiner Queries

I The withdrawal of Halvorson as an anticipatory rejection was made following a review of and in deference to an the earlier Board decision of Judges Abrams, McQuade and Frankfurt on another of inventors' applications involving a reversal of Halverson as an anticipatory reference and affirmation of Halvorson as an obviating reference on the same element in the mentioned related case.

The decision at appeal conference was to withdraw the Pearson '029 rejection as we had an anticipatory reference with all elements expressly or inherently present, there being no persuasive arguments from applicant on the anticipation rejections nor a subsequent timely filed 131 affidavit addressing claim 49 and claims depending therefrom rejections, and the Pearson '232 reference expressly incorporating the Pearson '029 reference anyway, so dropping the Pearson '29 obviousness rejection was done in the interest of simplification of issues.

II. Pearson '232 anticipates the cited rejected claims but for 42 & 44, so no differences in elements were articulated. Meador et al. was brought in as a secondary reference per it's inclusion of the elements in claims 42 and 44 Pearson '232 lacks. As anticipation is the epitome of obviousness, the combination of Pearson '232 and Meador et al. would obviate all but cited rejected claims 42 and 44 premised solely on the teachings of Pearson '232.

III Like the explanation on Pearson '232 in view of Meador et al., Pearson '232 anticipates the cited rejected claims but for 42 & 44, so no differences were articulated. Blechl et al. was brought in as a secondary reference per it's inclusion of the elements in claims 42 and 44 Pearson '232 lacks. As anticipation is the epitome of obviousness, the combination of Pearson '232 and Blechl et al. would obviate all but cited rejected claims 42 and 44 premised solely on the teachings of Pearson '232.

IV. R. Michael McGrady was identified as the inventor or co-inventor of at least one claim per the application declaration. Likewise the co-inventors were identified as inventors or co-inventors of one or more claims in the

application, but the application declaration does not identify which claims are invented or co-invented by each respective inventor. Applicant McGrady's 131 affidavit identifies himself in section 2 as a joint inventor of the subject of claims 38-53. The breadth of that statement includes both a macroscopic scope assertion that he is a joint or sole inventor on one or more claims as well as a microscopic scope that he is a joint inventor on each claim.

Applicant McGrady's 131 affidavit identifies himself as the sole inventor of claims 38 and 48 in section 5. That is not inconsistent with the non-affiant inventors being sole or joint inventors on at least one of the remaining claims in the application nor does it cast any doubt on their being properly identified joint inventors. It is entirely plausible that the remaining non-affiant joint inventors subsequently invented or co-invented the claimed matter of the claims depending from claims 38 and 48, or the claims not lineal dependents of claims 38 and 48. It is generally prevalent that dependent claims have at least as many co-inventors as the base claims as they subsequently build upon the earlier base work of the initial inventor. However, it is also very common for coworkers working on related

problems to independently conceive the same solution, so it is also highly plausible that the claimed subject scope of the dependent claims were the work of the coinventors of the application working independently. Had applicant McGrady's affidavit identified himself as the sole inventor of all claims, the inconsistency with the declaration by the omission of the application co-inventors would have shown evidence of a defective affidavit or declaration.

As the language of applicant's affidavit section 2 is nonspecific enough to encompasses both an macroscopic assertion that he is a joint contributor of claimed matter within the set of claims 38-53 or the alternative microscopic scope assertion that he is a joint inventor on each claim of 38-53, one finds the macroscopic scope is not inconsistent with the applicants' affidavit section 5, so affidavit sections 2 and 5 are not inconsistent with each other.

The examiner has no evidence refuting applicant's 131 affidavit attesting a conception date 9 months earlier than his priority date per parent application 08/186285 of the two claims 38 and 48 as established via the affidavit.

As applicant's affidavit swearing back nine months was not directed at the earliest priority date of Pearson '232, and Pearson '232 had the elements of applicant's broadest and earliest invented independent claims to which the affidavit was directed, the affidavit was ineffective in antedating Pearson '232 with respect to the two broader independent claims. The affidavit antedated one claim of a rejection in which the secondary reference Meador et al. was antedated, but that reference had been brought in anyway as part of a 103 rejection focused on a dependent claim, so withdrawal of the rejection of Pearson '232 in view of Meador et al. to claim 38 was not deemed critical in view of the remaining rejections. Pearson '232 is entitled to the priority date of Pearson '029 which is at least 8/29/91 with respect to the claims covered by the affidavit, and with some elements 11/8/89.

All rejections except the rejection to claim 38 having Meador et al. as a secondary reference were maintained in view of the affidavit date only antedating Meador et al. on the earliest invented claims. The examiner identified the elements on claim 38 in the face of the 131 affidavit merely

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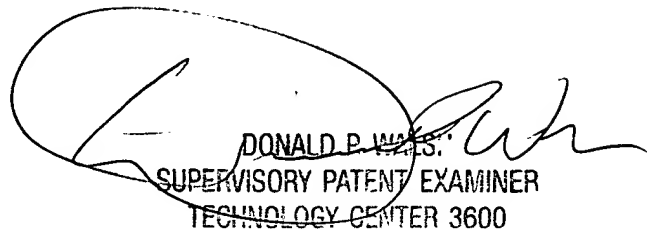
swearing between the filing date of Pearson '232 and its CIP linked ancestor applications by identifying elements in the Pearson '029 priority document, but the elements claim 38 which serve as the base of claims 39-47 were also identified in the Examiners Answer as the base of claims 39-47. But for the Pearson '232 and Meador et al. rejection to claim 38, all rejections remained intact so if the Board deems the 131 affidavit inadequate or defective, the Board can affirm the rejection to claims 38 and 48 without reliance upon the priority chain of Pearson '232 to Pearson '029.

The examiner hopes and believes this clarifies the questions raised by the Board in the remand.

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For the reasons cited in the Examiner's Answer, it is believed that the rejections should be sustained.

Respectfully submitted,


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9/9/04

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